

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of : HONG et al.
Serial No. : 11/035792
Filed : February 28, 2001
AND
International Application PCT/US02/31556
Filed : October 2, 2002
Title : Sugar Modified Nucleosides as Viral Replication Inhibitors

Mail Stop: PETITION
Commissioner for Patents
Post Office Box 1450
Alexandria, VA 22313-1450

RENEWED PETITION UNDER 37 C.F.R. 1.137(b)

Sir:

This is a renewed petition under 37 C.F.R. 1.137(b). It is in response to the decision by the PCT Legal Administration, dated April 22, 2005, on Applicants' petition to revive the above identified international application. A copy of the decision is attached as Exhibit A.

The Initial Decision

In the April 22 decision, applicants' petition under 37 C.F.R. 1.137(b) to revive the above identified international application was dismissed without prejudice, for failure to submit the "response" that was due on the date the application became abandoned. An appropriate response would have been a national stage application or a continuing application.

Because Applicants had mistakenly submitted with their Petition a Utility Patent Application transmittal, USPTO form SB/05, and not the appropriate form 1390 for a national stage filing under 35 USC 371, a national stage application was not created.

The application data sheet was intended to indicate that the application was the national stage filing of PCT/US02/31556, but it contained a typographical error in the cited PCT serial number, so that a reference under 37 CFR 1.78(a)(2) to PCT/US02/31556 as a priority document was not effected, and the Office was unable to construe that a continuing application had been created.

The April 22 decision incorrectly characterized the reference to the PCT application in the Data Sheet as a priority claim “to” a national stage application, rather than an indication that the application was intended to be the national stage. The misunderstanding is of no consequence *per se*, but Applicants believe that the Data Sheet, correctly understood, is evidence of their original intentions, should such evidence be relevant to a decision on this renewed petition. A copy of the Application Data Sheet is attached as Exhibit B.

Reasons for renewal of the petition

The application papers filed with the Petition for Revival were treated by the Office as an application under 35 USC 111(a), and forwarded as such to the O.I.P.E. where it was granted serial No. 11/035,792 and accorded a filing date of 12/02/2004. Applicants recognize that, under the circumstances, the Office may have had no other option for processing the application papers as they were submitted. However, in view of the publication of the international application more than one year prior to the assigned filing date, and the fact that the published international application was not co-pending as of that filing date, Applicants will not be able to secure allowance of claims in the 111(a) application, and must continue to seek revival of the international application.

With this renewed petition, applicants hereby submit PTO form 1390 and the national stage fees necessary to effect entry into the national stage, which was the intended effect of the originally-filed Petition. Applicants believe that, by this renewed petition, all requirements for reviving the above identified international application have been satisfied, and respectfully request that this renewed petition be granted.

Express abandonment

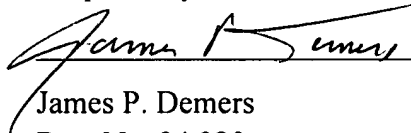
Applicants have expressly abandoned application No. 11/035,792, and as a result the examination of the '792 application will be avoided. Accordingly, to the extent that the Commissioner judges to be appropriate, a refund of a portion of the filing and extra claim fees submitted with the original Petition for Revival is hereby requested.

No petition fee is believed to be due in connection with this renewed petition. However, in the event that any fee is required, the Commissioner is hereby authorized to charge any fees which may be required, and to credit any overpayment or refund, to Deposit Account No. 02-4270, with reference to Docket No. 6319-4012. A duplicate copy of this paper is attached.

In the event that the Office has any further concerns or questions, applicants invite a call to the undersigned attorney at the number listed below.

Dated: May 19, 2005

Respectfully submitted,



James P. Demers

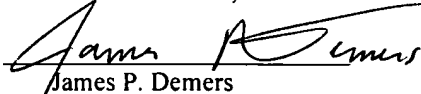
Reg. No. 34,320

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I hereby certify that this paper, and the papers referred to herein as being attached, are being deposited this date with the United States Postal Service with sufficient postage as Express Mail, Post Office to Addressee, with Label No. EV330372437US, addressed to: PCT Legal Staff, Mail Stop PCT, Commissioner for Patents, Post Office Box 1450, Alexandria, VA 22313-1450


James P. Demers

May 19 2005
Date

EXHIBIT B



22 APR 2005

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. Box 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

BROWN, RAYSMAN, MILLSTEIN, FELDER & STEINER LLP
900 THIRD AVENUE
NEW YORK, NY 10022

In re Application of	:	
HONG, Zhi	:	DECISION ON
Application No.: 11/035,792	:	
Filing Date: 02 December 2004	:	PETITION
Attorney Docket No.: 6319-4012	:	
For: SUGAR MODIFIED ... REPLICATION	:	UNDER 37 CFR 1.137(b)
INHIBITORS	:	

This decision is in response to applicant's petition "Petition For Revival of an International Application For Patent Abandoned Unintentionally Under 37 CFR 1.137(b)," filed in the United States Patent and Trademark Office on 02 December 2004.

BACKGROUND

On 02 December 2004, applicant filed a petition to revive international application PCT/US02/31556, a transmittal letter for a utility application, an application data sheet and the filing and revival fees.

On 22 February 2005, the Office mailed Notice to File Missing Parts of Non Provisional Application.

On 30 March 2005, applicant submitted a declaration of the inventor.

DISCUSSION

This petition was initially separated from the utility transmittal it accompanied and was assigned serial number 10/530,090. This was in error. The serial number 10/530,090 has been deleted. All correspondence relating to this petition should be directed to 11/035,792.

A petition to revive an abandoned application under 37 CFR 1.137(b) must be filed without intentional delay from the time the application became abandoned and/or applicant first became aware of the abandoned status of the application. A petition under 37 CFR 1.137(b) must be accompanied by (1) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unintentional, (2) a proposed response, (3) the petition fee required by law (37 CFR 1.17(m)), and (4) a terminal disclaimer and fee (if the international application was filed prior to June 8, 1995).

Applicant states "the entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional," as

required by 37 CFR 1.137(b)(3). The appropriate petition fee has been paid. A terminal disclaimer is not required as the application was filed on or after 08 June 1995.

As to item (2), the proper response is either the basic national fee or a continuing application under 35 U.S.C. 111(a). The instant application does not contain the reference required under 37 CFR 1.78(a)(2) to the international application and accordingly, does not constitute a "continuing" application. Specifically, the instant application does not indicate that it is a continuation, a continuation in part or a divisional of PCT/US02/31556. In the instant application, applicant filed an application data sheet claiming priority to "a national stage of" international application "PCT/US02/31556". The international application number is incorrect and in any event, a national stage application was not created.

CONCLUSION

The petition to revive international application PCT/US02/31556 abandoned under 37 CFR 1.137(b) is **DISMISSED** without prejudice.

This application is being forwarded to the Office of Initial Patent Examination for processing as a regular U.S. application under 35 U.S.C. 111(a).

Erin M. Pender

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Docket Date	RECEIVED APR 27 2005
BRMFS#	6319-4012
Attorney(s):	MB/DH/JPO
Action:	Request Reconsideration
Action Date:	6-22-05
Final:	
Initials:	UJ

EXHIBIT A

Application Data Sheet

Application Information

Application Number::

Filing Date::

Application Type: Regular

Subject Matter:: Utility

Suggested Classification::

Suggested Group Art Unit:: 1614

CD-ROM or CD-R?: None

Number of CD disks::

Number of copies of CDs::

Sequence submission?: No

Title:: Sugar Modified Nucleosides as Viral
Replication Inhibitors

Attorney Docket Number:: 6319-4016

Request for Early Publication?: No

Request for Non-Publication?: No

Suggested Drawing Figure::

Total Drawing Sheets:: 0

Small Entity:: No

Licensed US Govt. Agency::

Contract or Grant Numbers::

Secrecy Order in Parent Appl.: No

Applicant Information

Applicant Authority type:: Inventor

Primary Citizenship Country:: US

Status:: Full Capacity

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Middle Name::

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Name Suffix::
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State or Province of Residence:: CA
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Status:: Full Capacity

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 Middle Name::
 Family Name:: Zhong
 Name Suffix::
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 State or Province of Residence:: CA
 Country of Residence:: US
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 City of mailing address:: Laguna Niguel
 State or Province of mailing address:: CA
 Country of mailing address:: US
 Postal or Zip Code of mailing address:: 92677

Correspondence Information

Correspondence Customer Number:: 29858

Domestic Priority Information

Application::	Continuity Type::	Parent Application::	Parent Filing Date::
This Application	National Stage of	PCT/US02/31556	10/02/02